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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/605,290	06/28/2000	Howard Stein	PMS-265915 HS-1	5958
27498	7590	11/02/2004	EXAMINER	
PILLSBURY WINTHROP LLP 2475 HANOVER STREET PALO ALTO, CA 94304-1114			COLIN, CARL G	
			ART UNIT	PAPER NUMBER
			2136	

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/605,290

Applicant(s)

STEIN, HOWARD

Examiner

Carl Colin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6, 8 and 10-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 8 and 10-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ^d
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8/4/04 . e
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Arguments

1. In response to communications filed on 6/15/2004, applicant cancels claim 22 and amends claims 1, 8, and 21. The following claims 1-3, 6, 8, and 10-21, 23 and 24 are presented for examination.
2. The amendments to the abstract, filed on 6/15/2004 have been considered and the objection to the specification has been withdrawn. Claims 11 and 16 are still ambiguous and do not clearly support the explanation provided in the Applicant's response. The claim can still be interpreted as the medium having a face of an authorized user as the claim recites "the medium having an authorized user the authorized user having a face the image being free of an image of the face of the user. Applicant states that "the image being free of an image of the face of the authorized user" means the image is not the image of the face of the user. Applicant respectfully disagrees. The claim language means, on the other hand that the two images are not bound to each other. In addition, in claim 16 which is a claimed method of claim 11, Applicant recites scanning the medium to generate a digital representation of the image. One skilled in the art would still not understand which image the scanning step is referring to, whether it is referring to the image of the object or the image of the face of the user is unknown. Therefore, Examiner still maintains the rejection and the claims are also rejected as interpreted by Applicant.

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2.1 Applicant's arguments, pages 9-14, filed on 6/15/2004, with respect to the rejection of claims 1, 8, and 21 have been fully considered as amended, but are not fully persuasive.

Applicant argues that Piosenka does not teach storing an image as an encrypting passkey as amended. Upon further consideration a new ground of rejection is made in view of Berson in combination with Kaplan. The claim limitations not challenged by Applicant still apply in this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3.1 **Claims 11, 16, and the intervening claims** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. On the first step of claims 11 and 16, applicant incorporates as new matter "a medium having an authorized user having a face, the image being free of the face of the authorized user". In the written description, applicant fails to describe a photograph having an image of an object and a user face as described in the above claims.

Claim Objections

4. **Claim 1** and the intervening claims are objected to because of the following informalities: the term “adapted to” is not a positive limitation and should be corrected. Appropriate correction is required. See MPEP § 2106.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5.1 **Claims 1-3, 6, 8, 10-21, 23, and 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,742,685 to **Berson et al.** in view of US Patent 5,932,119 to **Kaplan et al.**

5.2 **As per claim 1, Berson et al.** substantially teaches an encrypting security device comprising a security photograph incorporating a multiplicity of picture elements; a scanner adapted to output a digital representation of the security photograph, for example (see column 3,

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lines 10-27); and a software program that is adapted to convert the digital representation of the security photograph into an encrypted passkey that is stored within the encrypting security device and further adapted to automatically match the encrypted passkey to the digital representation of the security photograph for allowing access to an associated apparatus; for example (see column 3, lines 10-46; column 4, lines 25-67; and column 5, lines 1-33 and column 6, lines 42-52). **Berson et al.** discloses that the invention can be applied to controlling access to secured area that meets the recitation of allowing and denying access to a secured apparatus, for example (see column 1, line 60 through column 2, lines 10). **Berson et al.** does not explicitly teach the security photograph having an image of an object, the object having a size, the image having a size that is greater than the size of the object. However, **Kaplan et al.** in an analogous art teaches a photograph with multiplicity of elements (see column 4, lines 1-12 and column 8, lines 1-15). **Kaplan et al.** further teaches a device used to magnify an object with an image greater than the size of the object (see column 12, lines 36-47 and column 15 lines 60 et seq.). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the photograph of **Berson et al.** with a photograph of an enlarged image of multiplicity of picture elements because each stone has varying characteristics that make each stone essentially unique as taught by **Kaplan et al.** (column 8, lines 1-15). This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **Kaplan et al.** so as to benefit from varying characteristics, details, and uniqueness of the image of the stone.

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As per claim 2, Kaplan et al. discloses access to a computerized control system using video pattern of a workpiece (see column 5, lines 25-38). Therefore, claim 2 is rejected on the same rationale as the rejection of claim 1.

As per claim 3, Berson et al. discloses the limitation of wherein the associated apparatus is selected from a group including a vehicle, a safe, a cash register, a locking system of a building, and an alarm system of a building (see column 1, line 55 through column 2, line 2).

As per claims 6 and 10, Kaplan et al. discloses the limitation of wherein the security photograph is an enlargement of the center of a gemstone (see column 12, lines 36-47 and column 15 lines 60 et seq.). Therefore, claims 6 and 10 are rejected on the same rationale as the rejection of claim 1.

As per claims 8, 11, and 16, claims 8 and 11 recite the same inventive concept as claim 1 except for incorporating the claimed device of claim 1 into a method and system. Therefore, claims 8 and 11 are rejected on the same rationale as the rejection of claim 1.

Claims 12-15, 17-20, and 21, 23, and 24 recite similar limitations as found in claims 1-10 above. Therefore, these claims are rejected on the same rationale as the rejection of claims 1-10.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6.1 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 703-305-0355. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Carl Colin

Patent Examiner

October 26, 2004


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100